

Application No. 10/081,478
Amendment Dated January 6, 2003
Reply to Office Action of September 9, 2003

REMARKS/ARGUMENTS

1. Remarks

The preliminary amendments have made to correct typographical errors in the Specification. No new matter is introduced by the amendments.

The present application is a continuation-in-part of US Patent Number 6,419,491. US Patent 6,419,491 contains Figs 1-14, which corresponds to Figs 9 - 22 of the present patent application. More importantly, Applicant points out that the parent application, now US Patent 6,419,491, claimed a dental implant system having a microgeometric arrangement as shown in Figs 9-22 of the instant application. However, the claimed invention was not restricted to a particular species of microgeometry. Therefore, the present restriction requirement is both problematic and inappropriate as discussed more fully below.

Figs. 2 - 5 of the instant patent application provide perspective views of the GTR membrane, either top (Fig 2 and 3) or bottom (Fig 4 and 5), which is claimed in Claims 1 - 10.

Figs. 6 - 8 are schematic views showing the application of the Instant invention at a wound site, but not depicting a particular microgeometry of the upper surface or lower surface of the flexible membrane.

As such, the Examiner has mistakenly required Applicant to restrict the claimed invention to one of 16 different species that are supposedly identified by Figs. 2-5 and 9-22. Therefore, Applicant is traversing this Restriction Requirement and requesting reconsideration of the Requirement in accordance with 37 CFR 1.143 and MPEP §818.03. Accordingly, Applicant provisionally elects, with traverse, Species A and Claims 1-10 which read on the elected species.

2. Arguments

Applicant respectfully requests reconsideration of the present restriction

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requirement. Applicant has trouble in responding to the Examiner's restriction requirement because the Examiner failed to explain or provide reasons and/or examples to support his conclusions that the restriction is appropriate. See MPEP §803 (Guidelines), 808, 814, 815 and 816.

In addition, the Examiner incorrectly concluded that there were no generic claims. Applicant respectfully directs the Examiners attention to Claims 1-10 and maintains that each of said claims generically claim the microgeometry shown in the figures. See MPEP §806.04(d) Definition of a Generic Claim. Therefore, Applicant does not fully appreciate the Examiner's action.

Still further, Applicant respectfully points out that the species chosen by the Examiner is not understandable. More specifically, Applicant points out on page 14, lines 3 – 4, the instant Specification states that the views of Figs. 13 and 17 correspond to the views of Figs. 3 and 5. Therefore, they are not independent, instead are directly correlated to one another. Furthermore, the microgeometry shown in Fig. 2, Species A, can have any of the cross sections shown in Figs. 15 thru 21, Species I thru Species O. Consequently, the microgeometry shown in Fig. 2, Species A, is the top view of various structures which have the cross sectional views of Figs. 15 thru 21, Species I thru O. Hence, Species A and Species I thru O are different views of the same structures, and they are not independent of one another. Moreover, on page 8, the second to third paragraph of the instant application, it is specifically stated:

"Figs. 9-14 are top plan views of potential microgeometries of either surface of the GTR membrane.

Figs. 15-22 are vertical cross-sectional views of possible GTR membrane surface geometries."

Such a relationship was also identified in the parent patent referenced above between the cross-sectional views of the grooves shown in Figs. 7-14 (Figs. 15-22 of the instant application) and the geometric patterns of the grooves shown in Figs. 1-6 (Figs. 9-14 of the instant application). In Column 5, line 27-31, it was stated specifically that "FIGS. 7 thru 14 are yz plane cross-sectional views of the patterns of FIGS. 1 thru

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6 showing variations in yz plane geometry, that is, relationship of grooves to ridges that applicable to one or more of the xy plane patterns shown in FIGS. 1 thru 6."

Therefore, the species designated by the Examiner are not appropriate for an election requirement.

Consequently, Applicant has referred to MPEP §808.01(a) Species in an effort to understand the Examiner's action, but such section clearly supports Applicant's position that no restriction is appropriate. Moreover, this section also requires the Examiner to at least allege that an unduly extensive and burdensome search would be required for the proper examination of the present claims. However, the Examiner has failed to present any reason that there would be a serious burden on the Examiner in examining the alleged species identified by the Examiner.

It is not readily understood that examining the alleged species encompassed by the generic claims would cause a serious burden on the PTO. On the other hand, the alleged inventions resulting from the restriction requirement would cause Applicants additional expenses and time to prosecute separate patent applications. The burden placed upon Applicants for filing separate cases directed to each of the species is respectfully submitted not to be outweighed by the burden placed upon the Patent Office by a non-coextensive examination of these groups in one application. Consequently, in the interest of efficiency, it is respectfully submitted that the restriction requirement is untenable and ought to be withdrawn.

Finally, Applicant refers to MPEP §802.01, 806.04(a)-(i) and 806.05-806.05(i) for support that the restriction is inappropriate. As provided therein, the question of restriction must be determined by both the practice applicable to election of species and the practice applicable to other types of restriction. If restriction is improper under either practice, it should not be required.

For example, the Examiner is respectfully requested to consider the restriction requirement under 35 U.S.C. §121 to elect a single invention. The requirements of §121 are that the inventions be independent and distinct. Both requirements are necessary to maintain a restriction requirement. Applicant respectfully maintains that

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the Examiner has not focused upon the two requirements of being independent and distinct. It is noted that MPEP §802.01 provides a definition of independent as follows:

The term "independent" [i.e., not dependent] means that there is no disclosed relationship between the two or more subjects disclosed, that is, they are unconnected in design, operation or effect, for example, [1] species under a genus which species are not usable together as disclosed or [2] process and apparatus incapable of being used in practicing the process.

The disclosure clearly indicates that the claimed microgeometry of an upper and lower surface of a flexible membrane are proportioned to a cell morphology and are used together in the article to heal wounds as provided in claims 1-10. The various claimed components are each applied within one device to serve the above purposes.

Accordingly, in view of the interdependence of the species encompassed by the claims and shown in the specification, and their clear use in the particular article used for healing of wounds and repair of tissue defects, it is respectfully requested that the restriction requirement be withdrawn and this application be examined as submitted. Alternatively, Applicant respectfully requests that the Examiner to withdraw the restriction requirement until the final office action pursuant to 37 CFR 1.142.

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Date of Signature

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